

REMARKS

Applicants have carefully reviewed the arguments presented in the Office Action and respectfully request reconsideration of the claims in view of the remarks presented below.

Claims 25, 29, 41-42 and 47 have been cancelled and claims 1, 8, 10, 14, 24, 27, 33, 38, and 40 have been amended. Thus, claims 1-24, 26-28, 30-40 and 43-46 are pending in the application.

Claims 1-7, 10-13, 19-20 and 38-39 were objected for various informalities. Claims 1, 10 and 38 were amended as appropriate to address the informalities noted by the Examiner, and also to correct inadvertent typographical errors. No new matter was added.

Claims 24 and 26 were rejected under 35 U.S.C. 102(b) as being anticipated by Tomkow (WO 01/10090). Applicant traverses these rejections. It is axiomatic that for a claim to be anticipated, each and every element of the claim must be found within the cited art. The various elements recited in claim 24, contrary to the Examiner's position, are neither disclosed nor suggested by the description and drawings of Tomkow.

Claim 24 as amended recites receiving a message including an attachment containing an identity of a sender of the message and instructions on how to authenticate the message in HTML format from a recipient at a web site. Nowhere does Tomkow teach or even suggest such a step. On page 41, Tomkow teaches a method whereby a recipient provides a copy of the message to the operators of the system. There is no mention of providing a copy to a web site. Moreover, at page 12, Tomkow only teaches appending a tag to the original message containing various information, such as "Visit our web site for more information." There is no mention of sending a copy to a web site for authentication, only to get more information. It would be mere hindsight to read into the passages of Tomkow that what the inventor meant was an instruction to submit a copy for authentication. Furthermore, those skilled in the art would understand the teachings of Tomkow at page 12 to be related to attaching a tag to a message, not attaching "an attachment" which is widely understood to mean, and indeed has been interpreted by the Examiner to mean, a separate file. In any case, Tomkow, nor any of the cited art, including Meyer, teaches an attachment including an identity of the sender and instructions on how to authenticate the message in HTML format. Meyer only teaches, as admitted by the Examiner, the inclusion of meta-content about the content of the message; Meyer does not teach or even

suggest including instructions on how to authenticate the message in HTML format in an attachment. Applicant respectfully submits that claim 24, and the claims dependent therefrom, are neither anticipated by, nor rendered obvious by the teachings of Tomkow. The Applicant therefore requests that the rejection be withdrawn and that claim 24 and its dependent claims be allowed.

Claims 1-23, 27-28, 30-32 and 40 were rejected under 35 U.S.C. 103(a) as being unpatentable over Tomkow, and further in view of Meyer et al. (US 2002/0143871). Applicant traverses these rejections.

Each of independent claims 1, 8, 14, 24, 27 33, 38 and 40 have been amended to recite a file or attachment containing instructions on how to authenticate a reply in HTML format. None of the art cited by the Examiner teaches or even suggests such when taken alone or in combination. As stated above, Tomkow and Meyer each fail to teach or suggest such an attachment. Nor do any of the other cited art.

Applicant further disagrees with the Examiner's various statements of motivation used to support the combination of references. For example, the Examiner's statement that "it would have been obvious because the ordinary person skilled in the art would have been motivated to simplify the use and management of e-mails for recipients" is nothing more than hindsight reconstructions. The HTML file or attachment claimed by Applicant is a tool to be used to authenticate an email message; as such it does not simplify the use and management of emails for a recipient. Applicant's invention requires the recipient of an email to send the email to a remote server to authenticate the content of the email. Such authentication has nothing to do with mere management of an email.

The Examiner also states "the ordinary person skilled in the art would have recognized the digital signatures/message digests as meta-content and would have been motivated include the meta-content in the HTML index attachment." There are no "index attachments" disclosed by Applicant in the specification. Once again the Examiner uses hindsight reconstruction to support an extremely tenuous association with a prior art reference that simply has nothing to do with the claimed inventions of this application. Meyer does not teach or even suggest, nor would one skilled in the art readily understand from reading Meyer, the steps of generating a digital signature of the message at the server, attaching the digital signature to an attachment that is not

part of the message to the message, and then authenticating the message to the recipient, as is claimed in amended claim 1. Meyer only discloses converting plain email text to HTML (See, ¶¶ 90, 135). Meyer embeds meta content in the email as an object (See, ¶¶ 8, 14, 43 and 142). Moreover, Meyer discloses embedding such content in "index fields" into the converted document, not including an embedded string in a separate HTML document that is then attached as a separate document to the original email, as is claimed in amended claim 1. Given the Examiner's statement that Tomkow also does not disclose the attachment of a separate HTML file to a message, combining Tomkow and Meyer still would not provide to one skilled in the art the novel combination of steps contained in amended claims 1, 8, 14, 24, 27 33, 38 and 40. For these reasons, Applicant respectfully submits that amended claims 1, 8, 14, 24, 27 33, 38 and 40 and their dependent claims are patentable over the cited art and request that the rejections be withdrawn and that the claims be allowed.

Claims 43-45 were rejected under 35 U.S.C. 103(a) as being unpatentable over Tomkow and Menezes, and further in view of Stark et al (US 2002/0131566). Applicant respectfully traverses these rejections.

Claim 43 recites "In a method of authenticating at a recipient a message and an attachment transmitted from a sender to the recipient through a server displaced from the recipient. . . ." The claim also recites providing at the recipient a compressed and encrypted string including an identification of the sender, the message, a hash of the attachment and an embedded has of the string. The claim also recites decompressing the string, decrypting the decompressed string, hashing the string less the embedded hash of the string, and then comparing the hash of the string less the embedded hash of the string and the embedded hash. All of these steps are done at the recipient.

Contrary to the Examiner's position, Tomkow does not disclose these steps. Tomkow discloses, on page 40, lines 19-32, a method for registering incoming emails to a recipient. Applicant agrees that Tomkow discloses that the message placed into recipient's in-box may have verification and information features, including a message digest and digital signature and message routing, information and tags. However, Tomkow only states that the message received by the recipient may have these features. Tomkow, and all of the other art cited by the

Examiner, is silent regarding processing the information received by the recipient at the recipient to authenticate the message, as is claimed in claim 43.

Further, while Stark does disclose the concept of compressing information to make an email smaller, Stark does not teach or even suggest providing a compressed and encrypted string including an identification of the sender, the message, a hash of the attachment and an embedded hash of the string, decompressing the string, decrypting the decompressed string, hashing the string less the embedded has of the string, and comparing the hash of the string less the embedded hash of the string and the embedded hash, as is claimed in amended claim 43.

Even combining the teachings of Stark and Menezes with Tomkow would not provide one skilled in the art all of the steps claimed in claim 43 because those steps are not taught or even suggested by the combined references. Not even if the references are combined using impermissible hindsight is claim 43 taught or suggested by those references.

For all of these reasons, Applicant respectfully submits that claim 43, and the claims dependent thereon, are patentable over the cited art, and requests that the rejections be withdrawn and that claims 43 and its dependent claims be allowed.

Claim 46 was rejected under 35 U.S.C. 103(a) as being unpatentable over Tomkow and further in view of Menezes et al. (Handbook of Applied Cryptography). Applicant traverses this rejection.

Claim 46 recites "In a method of authenticating at a recipient a message and an attachment transmitted from a sender to the recipient. . . . " Thus, claim 46, like claim 43, is directed to authenticating a message and an attachment received by a recipient at the recipient, and not at a server removed from the recipient, as is taught by Tomkow at page 41, lines 19-32. In fact, Tomkow specifically states, at page 41, lines 28-32 that "in the event that the recipient of a message should require evidence that an e-mail with a specific content was received at a particular time, the recipient can present a copy of the registered version 74 (FIG. 8) of the e-mail message 70 to the operators of the system for verification." Claim 46 accomplishes the authentication at the recipient, not at the "operators of the system." This conclusion is further supported by the subject matter of Tomkow found on page 41-line 33 to page 42 line 15, which discusses the authentication process carried out by the system operators and what information can be warranted by the system operators. One skilled in the art would immediately recognize

that this subject matter has nothing to do with authenticating the message at the recipient, since the process would be carried out by the recipient, not the "system operators."

Further, combining Tomkow with Menezes et al as suggested by the Examiner still does not yield the invention claimed in claim 46. Menezes does discuss use of hash and encryption, but it does not disclose a process for authenticating a message and an attachment by processing the message and attachment at a recipient. Thus, it adds nothing other than the disclosure of the use of hashes and digital signatures to Tomkow, subject matter already disclosed by Tomkow.

For all of these reasons, Applicant respectfully submits that claim 46 is patentable over the cited art, and requests that the rejections be withdrawn and that claim 46 be allowed.

Claims 33-37 were rejected under 35 U.S.C. 103(a) as being unpatentable over Tomkow and Meyer, and further in view of and Stark. Applicant traverses these rejections.

Claim 33 was amended to recite that the attachment contains instructions on how to authenticate a message and is in the form of an HTML file that is not part of the message. As discussed above with regard to claims 1, 8, 14, 24, 27 33, 38 and 40, neither Tomkow, Meyer or Stark teach or even suggest such a combination of steps as are recited in amended claim 33.

As discussed previously, Tomkow only teaches attaching a tag that may contain information such as "Visit our web site . . . for more information." Tomkow does not teach or even suggest including instructions on how to authenticate a message in HTML format in an attachment to the message. Moreover, Meyers also does not teach including instructions on how to authenticate a message, nor does Stark. Stark is only used by the Examiner to show that compression of a message was known to those skilled in the art. Accordingly, even if all of the references are combined as suggested, one skilled in the art would still not obtain the method of authenticating a message and an attachment as claimed by Applicant in amended claim 33. A

Further, as discussed above with reference to amended claim 1, among others, Meyer does not teach or even suggest, nor would one skilled in the art readily understand from reading Meyer, the steps of generating a digital signature of the message at the server, attaching the digital signature to an attachment that is not part of the message to the message, and then authenticating the message to the recipient, as is claimed in amended claim 1. Meyer only discloses converting plain email text to HTML (See, ¶¶ 90, 135). Meyer embeds meta content in

the email as an object (See, ¶¶ 8, 14, 43 and 142). Moreover, Meyer discloses embedding such content in "index fields" into the converted document, not including an embedded string in a separate HTML document that is then attached as a separate document to the original email, as is claimed in amended claim 33. Given the Examiner's statement that Tomkow also does not disclose the attachment of a separate HTML file to a message (with reference to claim 1), combining Tomkow and Meyer still would not provide to one skilled in the art the novel combination of steps contained in amended claim 33.

For these reasons Applicant submits that claim 33 is not obvious in view of the cited art, taken alone or in combination as suggested by the Examiner, and respectfully requests that the rejection be withdrawn and that claim 33 and the claims dependent therefrom be allowed.

Claims 38-39 were rejected under 35 U.S.C. 103(a) as being obvious in view of Tomkow and Meyer, and further in view of Kaufman et al (US Patent No. 5,764,772). Applicant traverses this rejection.

Similarly to claim 33, claim 38 was amended to recite an HTML file containing instructions on how to authenticate a message. As discussed previously, neither Tomkow nor Meyer teach or even suggest such a file. Moreover, adding Kaufman to the mix still does not provide to one skilled the art the invention claimed in amended claim 38, because Kaufman fails to teach or even suggest attaching an HTML file containing instructions on how to authenticate a message. Applicant submits that amended claim 38, and claim 39 dependent therefrom, is patentable over the cited art. Accordingly, Applicant respectfully requests that the rejection be withdrawn and that claim 38, and claim 39 dependent therefrom, be allowed.

CONCLUSION

Applicants have carefully reviewed the arguments presented in the Office Action and respectfully request entry of the amendment and reconsideration of the claims in view of the remarks presented. In light of the above amendments and remarks, Applicants respectfully request that a timely Notice of Allowance be issued in this case.

Should the Examiner have any questions concerning the above amendments and arguments, or any suggestions for further amending the claims to obtain allowance, Applicants request that the Examiner contact Applicants' attorney, John Fitzgerald, at 310-242-2667.

The Commissioner is authorized to credit any overpayment or charge any additional fees in this matter to our Deposit Account No. 06-2425.

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Respectfully submitted,

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